

REMARKS

This is a full and timely response to the outstanding final Office Action mailed January 14, 2004. Reconsideration and allowance of the application and presently pending claims 16, 18-32, 35-37 and 39-51, as amended, are respectfully requested.

1. **Present Status of Patent Application**

Upon entry of the amendments in this response, claims 16, 18-32, 35-37 and 39-51 remain pending in the present application. More specifically, claims 16, 18, 20, 23, 24, 26-28, 36 and 39 are directly amended, claims 11-15, 17, 33, 34 and 38 are canceled; and claims 40-51 are added. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

2. **Request for Continued Examination**

In accordance with 37 U.S.C. 1.114, a Request For Continued Examination is filed concurrently with this Response To The Final Office Action so that the Office Action mailed January 14, 2004 (Paper No. 7) is effectively made non-final.

3. **Acknowledgement of Allowable Subject Matter**

Applicant acknowledges the Examiner's conclusion that the subject matter of claims 34, 38 and 39 is allowable, as noted in paragraphs 8 and 9 of the Office Action. Accordingly, Applicant has amended independent claim 28 (to include the limitations of claim 34 and intervening claim 33) and independent claim 36 (to include the limitations of claim 38).

4. **Response to Rejection of Claims 28-30 and 32-35 Under 35 U.S.C. §101**

In the Office Action, claims 28-30 and 32-35 stand rejected under 35 U.S.C. §101 as allegedly being unpatentable because the claimed invention is directed to non-statutory subject matter.

Applicant has amended claim 28 to overcome the rejection of claim 28. Also, since independent claim 28 is amended to claim statutory subject matter, the claimed subject matter of dependent claims 29-30, 32 and 35 is now statutory. Claims 33 and 34

are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot.

Applicant thanks the Examiner for his suggested amendment. Applicant requests withdrawal of the rejection under 35 U.S.C. §101 to pending claims 28-30, 32 and 35.

6. Response to Rejection of Claims 11-14, 16-20, 23-26, 28-33 and 35-37 Under 35 U.S.C. §103(a)

In the Office Action, claims 11-14, 16-20, 23-26, 28-33 and 35-37 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Huberman* (U.S. Patent 5,826,255), in view of the Applicant's admitted prior art beginning on page 2, line 21 and ending on page 3, line 15 (hereinafter referenced by the term "*Bidding Elf*"). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

a. Basis for Rejection in the Office Action

In the Office Action, the above-listed claims are rejected as allegedly being unpatentable over *Huberman* in view of the Applicant's admitted prior art (the "*Bidding Elf*"). However, in some instances, Applicant is unable to determine what teaching, disclosure or suggestion in *Huberman* is used to provide the basis of a particular claim rejection. In those instances the Office Action does not point out with particularity precisely "where" in *Huberman* the subject matter of the rejected claim is allegedly taught, disclosed or suggested. MPEP section 706.02(j) indicates that "it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. ... It is important that the written record clearly explaining the rational for decisions made during prosecution of the application."

For example, in the rejection of claim 17, the Office Action alleges that in "[claim 17] the logic for processing further comprises: logic for determining the leading

bids and minimal bid increments for the good or service on each of the plurality of auction entities.” Applicant cannot find where in *Huberman* the feature of a “minimal bid *increment*” is taught, disclosed or suggested. In the absence of an indication by the Office Action precisely where in *Huberman* the features of the rejected claim are allegedly disclosed, the Applicant must, at best, “guess” at what portion of *Huberman* the Office Action intended to base the rejection of claim 17 upon.

Thus, in a rejection where the basis for the rejection of a claim is unclear, the Applicant does not have the requisite fair opportunity to reply to the Office Action allegation with particularity. Accordingly, Applicant respectfully requests that in the next Office Action the Examiner point out with particularity precisely where in a cited reference a feature of a rejected claim is taught, disclosed or suggested.

b. Claims 11-14

Claims 11-14 are canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to these claims are rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the canceled subject matter to the public.

c. Claims 16-20, 23-26

Applicant respectfully submits that claim 16, as amended, is allowable for at least the reason that the proposed combination of *Huberman* in view of the Applicant’s alleged admitted prior art does not disclose, teach, or suggest at least the feature of “logic for selecting a lowest bid from the determined bids, wherein when a plurality of the bids are equal, the logic for selecting further comprises logic for selecting the lowest bid having an earliest auction finish time” as recited in claim 16.

Huberman does not disclose, teach, or suggest using at least “logic for selecting a lowest bid from the determined bids, wherein when a plurality of the bids are equal, the logic for selecting further comprises logic for selecting the lowest bid having an earliest auction finish time.” Thus, *Huberman* fails to disclose, teach or suggest every

element of the Applicant's claimed invention as recited in claim 16. Also, the alleged Applicant's admitted art fails to disclose the above-described feature of claim 16.

Accordingly, the proposed combination of *Huberman* in view of the Applicant's alleged admitted prior art does not teach at least the claimed limitations of a "logic for selecting a lowest bid from the determined bids, wherein when a plurality of the bids are equal, the logic for selecting further comprises logic for selecting the lowest bid having an earliest auction finish time" as recited in claim 16 since neither *Huberman* or the Applicant's alleged admitted prior art individually disclose, teach or suggest the above-recited feature. Therefore, a *prima facie* case establishing an obviousness rejection by Applicant's alleged admitted prior art has not been made. Thus, claim 16 is not obvious under proposed combination and the rejection should be withdrawn.

Because independent claim 16 is allowable over the cited art of record, dependent claims 17-20 and 23-26 (which depend from independent claim 16) are allowable as a matter of law for at least the reason that the dependent claims 17-20 and 23-26 contain all features/elements of independent claim 16. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to claims 17-20 and 23-26 should be withdrawn.

d. Claims 28-33 and 35

Applicant has amended independent claim 28 to include the limitations of claim 34 and intervening claim 33. Since amended claim 28 corresponds to the allowable subject matter of claim 34 amended into independent claim format (including the subject matter of its original independent claim and any intervening claims), Applicant believes that claim 28 is in condition for allowance, and that the rejection to this claim should be withdrawn.

Because independent claim 28 is allowable over the cited art of record, dependent claims 29-33 and 35 (which depend from independent claim 28) are allowable as a matter of law for at least the reason that the dependent claims 29-33 and 35 contain all features/elements of independent claim 28. Accordingly, the rejection to claims 29-33 and 35 should be withdrawn.

e. Claims 36, 37 and 39

Applicant has amended independent claim 36 to include the limitations of claim 38. Since amended claim 36 corresponds to the allowable subject matter of claim 38 amended into independent claim format (including the subject matter of its original independent claim), Applicant believes that claim 36 is in condition for allowance, and that the rejection to this claim should be withdrawn.

Because independent claim 36 is allowable over the cited art of record, dependent claims 37 and 39 (which depend from independent claim 36) are allowable as a matter of law for at least the reason that the dependent claims 37 and 39 contain all features/elements of independent claim 36. Accordingly, the rejection to claims 37 and 39 should be withdrawn.

6. Response to Rejection of Claims 15, 21 and 22 Under 35 U.S.C. §103(a)

In the Office Action, claims 15, 21 and 22 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Huberman* in view of the “*Bidding Elf*” in further view of *Ortega et al.* (U.S. Patent 6,549,904).

Claim 15 is canceled without prejudice, waiver, or disclaimer, and therefore, the rejection to this claim is rendered moot. Applicant takes this action merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of this canceled claim in a continuing application, if Applicant so chooses, and does not intend to dedicate any of the canceled subject matter to the public.

Because independent claim 16 is allowable over the cited art of record, dependent claims 21-22 (which depend from independent claim 16) are allowable as a matter of law for at least the reason that the dependent claims 11-22 contain all the limitations of independent claim 16. Accordingly, the rejection to these claims should be withdrawn.

7. Response to Rejection of Claim 27 Under 35 U.S.C. §103(a)

In the Office Action, claim 27 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Huberman* in view of the “*Bidding Elf*” in further view of *Zandi* (U.S. Patent 5,966,699).

Because independent claim 16 is allowable over the cited art of record, dependent claim 27 (which depends from independent claim 16) is allowable as a matter of law for at least the reason that the dependent claim 27 contains all the limitations of independent claim 16. Accordingly, the rejection to this claim should be withdrawn.

8. Newly Added Claims 40-51

New claims 40-51 are based on subject matter that is explicit and/or inherent within the description of the specification and/or the drawings. Applicant submits that no new matter has been added in the new claims 40-51, and that new claims 40-51 are allowable over the cited prior art. Therefore, Applicant requests the Examiner to enter and allow the above new claims.

9. Change of Correspondence Address

Applicant submits herewith a Change of Correspondence Address Application indicating that further correspondence should be sent to Hewlett-Packard Company; Intellectual Property Administration, at P.O. Box 272400 in Fort Collins, CO, 80527-2400.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 16, 18-32, 35-37 and 39-51 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

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